

### REMARKS

Status of the Claims: As of the receipt of the Non-Final Office Action dated December 14, 2009, Claims 1-29 are pending and Claim 30 is withdrawn. As of this amendment, Claim 1 is amended herein.

The Examiner has rejected claims 1-11 and 13-14 under 35 U.S.C. 103(a) over *Noe* (U.S. 5,494,055). Applicant respectfully traverses this rejection.

*Noe* is directed towards the provision of a smoking article which resembles a conventional smoking article but which has side-stream smoke which is weak, non-irritating, and has a pleasantly tobacco-like odor. This is achieved in *Noe* by applying an aroma mixture to the wrapper of the smokeable material, which may be a double wrapper, wherein the inner wrapper is highly porous. The outer wrapper of *Noe* comprises conventional cigarette paper. Therefore while *Noe* discloses a smoking article having a weak, non-irritating odor (see *Noe*, column 2, lines 4 and 5), the embodiments of the present invention are focused on delivering an enhanced and thus increased amount of flavourant into the sidestream (see page 2, lines 8-11 of the present application, i.e. International Publication WO 2004/052128A3). In the development of the embodiments of the present invention it has surprisingly been found that to achieve this aim, it is advantageous to have an outer wrapper that is far more porous than the inner wrapper (see paragraph spanning pages 16 and 17 of the present application).

*Noe* discloses that its inner wrapper has a porosity that is between 10 and 1000 times greater than that of the outer wrapper. It is stated in *Noe* that the two wrappers must have these relative porosities “*in order to guarantee control of the burn-off behavior of the cigarette*

*through the outer layer alone*" (column 4, line 17). In addition, Examples 1 to 3 of *Noe* illustrate the effect of incorporating the aroma mixture in the specific manner advocated by *Noe*. The inner, highly porous wrapper is shown to prevent so-called condensate strips arising and to avoid the unwanted increase in the number of draws.

In other words, *Noe* teaches that the wrappers should be arranged in this way in order to ensure that the burn characteristics of the smoking article resemble those of a conventional cigarette. In contrast, the embodiments of the present invention provide a smoking article having a conventional appearance and smoking characteristics despite having an outer wrapper that is more porous than the inner wrapper, and yet delivers an enhanced amount of flavourant into the sidestream smoke.

The Examiner states that in light of the teaching of *Noe* it would have been obvious to reverse the porosities of the inner and outer wrappers. However, in light of the general teaching of the *Noe* document, the skilled person would expect that reversal of the wrappers would result in a smoking article that burns in an unconventional fashion and is unsightly in appearance. There is also nothing in *Noe* to suggest that this reversal would improve the flavouring of the sidestream smoke.

Therefore, the teachings of *Noe* are clearly teachings away from Applicant's embodiments and provide the skilled person with no incentive to reverse the positions of the two wrappers with the expectation that the resulting smoking article would be acceptable to consumers and would provide better masking of the odor of the sidestream smoke.

Accordingly Applicant hereby respectfully traverses the assertion of the Examiner that Applicant's embodiments are obvious or would be well known in the art, under the provisions of MPEP 2144.03, and requests that the Examiner provide documentary evidence of that assertion, or provide an appropriate affidavit.

The Examiner states that claims 7 to 9, 10, 11, and 13 to 14 also recite additional subject matter that is obvious in light of the *Noe* document. However, these claims are directly or indirectly dependent on claim 1, and are therefore patentable over *Noe* for the same reasons set forth above.

Claims 11 and 12 have been rejected under 35 U.S.C. 103(a) over *Noe* in view of *Griffiths, et al. (Griffiths)*

*Griffiths* discloses a method for isolating genetic elements in order to perform in vitro evolution of nucleic acids. The disclosed process comprises compartmentalizing genetic elements into microcapsules.

35 U.S.C. 103(a) forms the basis for all obviousness rejections set forth in the current Office Action only if “*the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.*”

The subject matter of the present application pertains to flavoured smoking articles. The relevant person having ordinary skill in the art is therefore assumed to be aware of the published information relating to flavoured smoking articles. However, there is no reason to assume that

this person would have any knowledge of microcapsules for use in genetic systems used in performing in vitro evolution of nucleic acids, as this is clearly an unrelated field. As such, Applicant submits that the claimed subject matter as a whole would not have been obvious to the person having ordinary skill in the art. In addition claims 11 and 12 are directly or indirectly dependent from claim 1 and are therefore patentable for the reasons set forth therefor.

Claims 11 and 12 have also been rejected under 35 U.S.C. 103(a) over *Noe* in view of *Whatley*.

Claims 11 and 12 are directly or indirectly dependent from claim 1, and as such are patentable for reasons detailed above.

In addition *Whatley* discloses a number of methods for the manufacture of microcapsules, but does not appear to make any reference to smoking articles, or to wrappers for smokeable material. Consequently, the person skilled in the art would not be taught, suggested, or motivated to combine the teachings of *Whatley* with that of *Noe* to arrive at the subject matter of Claim 1 or the claims dependent therefrom of the present application.

Claims 14 to 19 have been rejected under 35 U.S.C. 103(a) over *Noe* in view of *Boden*.

The *Boden* patent is directed towards a group of structurally related chemicals which may be used as flavourants, for example in smoking articles. However, *Boden* does not teach that the flavourants therein may be used with smokeable material having a double layer of wrapping, and wherein the wrapping comprises an outer layer with a total permeability of at least 200 CU, and which is greater than the permeability of the inner layer, to provide enhanced delivery of flavour

into the sidestream smoke. As a result, *Boden* does not cure the deficiencies of *Noe* as a reference as discussed above in connection with Claim 1 and its dependent claims 14 to 19.

The Examiner has rejected Claims 14, 21 to 23, and 25 to 28 under 35 U.S.C. 103(a) over *Noe* in view of *Yoshida*.

*Yoshida* discloses a family of chemical compounds which are suitable for use as flavourants in consumable material such as smoking materials. *Yoshida* teaches that the disclosed compounds may be incorporated into smoking articles using any convenient method (see column 29, lines 6 to 8). *Yoshida* does not disclose smokeable material having a double layer of wrapping, and in particular, does not teach the use of an outer wrapper that is more porous than the inner wrapper in combination with a flavourant in order to provide enhanced delivery of flavor into the sidestream smoke. Accordingly *Yoshida* does not cure the deficiencies of *Noe* as a reference as described above with regard to Claim 1 or to its dependent claims 14, 21 to 23, and 25 to 28. As a result, from the combined teaching of *Yoshida* and *Noe*, the skilled person could not have arrived at the subject matter of Claim 1 of the present application.

Claim 29 has been rejected under 35 U.S.C. 103(a) over *Noe* in view of *Owens*.

The present application relates to providing a smoking article in which an enhanced amount of flavourant is delivered to the sidestream rather than the mainstream smoke.

In contrast, *Owens* discloses a ventilated filter cigarette that is designed to impart a volatile flavouring agent into the mainstream cigarette smoke, and *Owens* teaches that it is disadvantageous for flavourant to be carried in the sidestream rather than the mainstream smoke

(see column 1, lines 17 to 19). This is a clear teaching away from the embodiments of the present invention. Clearly, in light of this teaching, the skilled person would not have turned to *Owens* for information regarding smoking articles in which it is intended that an enhanced amount of flavourant is transmitted to the sidestream smoke.

Even if the skilled person had investigated the *Owens* patent, they could not combine the teaching of *Owens* with that of *Noe* to arrive at the subject matter of Claim 1 of the present application.

As described above, in respect of a smoking article comprising a double layer wrapper, *Noe* teaches away from the use of an outer wrapper that is more porous than the inner wrapper. *Owens* on the other hand does not even discuss the use of double wrappers. Furthermore, *Owens* is exclusively directed towards the incorporation of flavourant onto the filter wrapper wherein the flavourant is not pyrolyzed, and not the incorporation of the flavourant into the wrapper surrounding the tobacco rod wherein the flavourant is pyrolyzed with the tobacco. These are starkly different uses of a flavourant.

Additionally, since claim 29 is dependent from claim 1, then the subject matter recited therein is patentable for all the reasons set forth above.

Accordingly this application is now in condition for allowance, and such action is respectfully requested.

The Examiner is invited to call the undersigned attorney if there are any further issues that need discussion.

Respectfully submitted,

/Charles I. Sherman/

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